

REMARKS

Reconsideration of the application, as presently amended, is respectfully requested. Claims 21-23 and 25 have been amended. No claims have been cancelled. New claim 31 has been added.

Claims 22-23 and 25 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicant regards as the invention. In response to the rejection of claims 22-23 and 25, Applicant has amended claims 21-23 and 25. Claim 21 has been recast as an independent claim. Applicant respectfully requests that the rejection of claims 22-23 and 25 be withdrawn.

Claims 1-30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,809,416 to Pinault et al. ("Pinault") in view of U.S. Patent No. 5,666,650 to Turcotte et al. ("Turcotte"). Pinault has been cited as disclosing all of the features of the rejected claims except that ". . .the list of data associated with neighboring networks is received at the mobile station." Turcotte is cited as disclosing ". . .a list of data [] received at the mobile station. . . ."

Pinault appears to teach seeking of a connection by a mobile terminal to a network of a plurality of networks. In Pinault, a two-stage process is performed. In a first stage, the mobile terminal measures the power of all received channels in order to determine various networks to which the mobile terminal may connect. The mobile terminal then classifies the channels in decreasing power order. Following the channel classification by power, the mobile terminal consults data held in a memory of the mobile terminal that includes identification codes for the country of origin and various countries adjacent to a network to which the mobile terminal is currently connected. Based upon the classified power order of the channels and the data in the memory of the mobile terminal, the mobile terminal may connect to a home network of the mobile terminal.

The Office Action has conceded that Pinault fails to teach or suggest the feature of independent claim 1 of receiving at the mobile station a list of data associated with networks neighboring a PLMN currently serving the mobile station of claim 1, the feature of transmitting

from a base station associated with a serving PLMN to the mobile station a list of neighboring PLMNs of claim 13, the feature of transmitting from a base station associated with a serving PLMN to the mobile station at least one mobile country code associated with a neighboring network of claim 21, and a neighbor list containing data received from the serving PLMN enabling selection of a PLMN neighboring the serving PLMN as a new serving PLMN of claim 26.

In contrast to independent claims 1, 13, 21, and 26, in Pinault, the mobile terminal maintains a list stored in memory of all neighboring countries to a country the mobile station is currently located in. The stored list is used in an effort to avoid unnecessary searching for a geographically-distant PLMN. Pinault requires that all possible locations to which the mobile terminal could be taken and neighbors of those locations be stored in the mobile terminal. In contrast to Pinault, in various embodiments of the invention, the network to which a mobile station is connected provides to the mobile station necessary information regarding networks neighboring a PLMN currently serving the mobile station.

Turcotte is directed to a broadcast list that identifies cells neighboring a cell to which the mobile terminal is connected. The broadcast list directs the mobile station to measure the strength of the cells contained in the broadcast list and to report these measurements to the network.

In contrast to each of independent claims 1, 13, 21, and 26, Turcotte fails to teach or suggest receiving at the mobile station a list of data associated with networks neighboring a PLMN currently serving the mobile station (claim 1), transmitting from a base station associated with a serving PLMN to the mobile station a list of neighboring PLMNs (claim 13), transmitting from a base station associated with a serving PLMN to the mobile station at least one mobile country code associated with a neighboring network (claim 21), or a neighbor list containing data received from the serving PLMN enabling selection of a PLMN neighboring the serving PLMN as a new serving PLMN (claim 26). The broadcast list of Turcotte pertains to particular neighboring cells and not to the particular features of each of independent claims 1, 13, 21, and 26, respectively, that are listed above.

Applicant respectfully submits that Turcotte's disclosure of a broadcast list that identifies cells neighboring a cell to which the mobile terminal is connected fails to cure the deficiencies noted above of Pinault. Withdrawal of the rejection of independent claims 1, 13, 21, and 26 is respectfully requested.

In addition, Applicant respectfully submits that there is no motivation to combine Pinault and Turcotte as suggested by the Office Action. As noted above, Pinault is directed to a mobile terminal that maintains a list of countries that neighbor countries to which the mobile terminal might be connected. Turcotte is directed to a broadcast list of cells that neighbor a cell to which the mobile terminal is connected, which cells the mobile terminal is directed to measure and report the measurements thereof to the network to which the mobile terminal is connected. Applicant respectfully submits that a person of ordinary skill, when presented with Pinault, would in no way be motivated to modify the teachings of Pinault to include the teachings of Turcotte, at least because Turcotte in no way relates to determining which countries neighbor a country to which the mobile terminal might be connected.

Claim 31 has been added. Applicant respectfully submits that claim 31 distinguishes over the cited combination of references for similar reasons to those set forth above and also because claim 31 includes the feature of selecting a new PLMN to serve the mobile station from the PLMNs neighboring the PLMN currently serving the mobile station based upon information received at the mobile station identifying networks neighboring a PLMN currently serving the mobile station.

In view of the above, each of the presently-pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Application No.: 09/849086

Docket No.: 34650-00687USPT

Dated: May 18, 2004

Respectfully submitted,

By



Ross T. Robinson

Registration No.: 47,031

JENKENS & GILCHRIST, A PROFESSIONAL
CORPORATION

1445 Ross Avenue, Suite 3200

Dallas, Texas 75202

(214) 855-4500

(214) 855-4300 (Fax)

AI 31. (New) A method for selecting a public land mobile network to serve a mobile station, comprising the steps of:
receiving at the mobile station information identifying networks neighboring a PLMN currently serving the mobile station;
selecting a new PLMN to serve the mobile station from the PLMNs neighboring the PLMN currently serving the mobile station based upon the identifying information; and
changing the mobile station to the selected new PLMN.
